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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/011,659	11/29/2001	Eric R. George	ZE-46	6878

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/011,659

Applicant(s)

GEORGE ET AL.

Examiner

Walter B Aughenbaugh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 73 and 85.

Claim(s) rejected: 67-85.

Claim(s) withdrawn from consideration: 42-54 and 56-66.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## ADVISORY ACTION

### *Acknowledgement of Applicant's Amendments*

1. The After Final Amendment filed June 29, 2004 has not been entered due to the fact that the amendments raise new issues that would require further consideration and search. New independent claims 86-88 that were filed June 29, 2004 are broader than independent claims 67, 74 and 79: claims 86-88 do not limit the diameter of the tubing as claims 67, 74 and 79 do and do not require the mechanical property limitations of claims 67, 74 and 79, and consequently, a broader search must be performed.

### *Answer to Applicant's Arguments*

2. Applicant's arguments on pages 9-12 of the After Final Amdt. that support Applicant's first point of argument have been fully considered but are not persuasive. Bagaoisan plainly teaches that a blend of PEBAX and nylon is a suitable material for the tube portion of the catheter at col. 9, lines 15-16. Contrary to Applicant's argument, Bagaoisan does not teach that blending PEBAX in nylon reduces the modulus of elasticity of the nylon: the teaching at col. 5, lines 51-54 that Applicant cites does not state or suggest that blending PEBAX in nylon reduces the modulus of elasticity of the nylon but only indicates that PEBAX is less stiff than PTFE. The selection of Beall cited by Applicant on page 11 of the After Final Amdt. does not indicate that both an increase in tensile modulus and in ultimate impact resistance cannot be obtained as Applicant contends; Beall is silent on this matter in this selection of Beall.

3. Applicant's arguments on pages 12-13 of the After Final Amdt. that support Applicant's second point of argument have been fully considered but are not persuasive. As discussed in the response provided above to Applicant's first point of argument,

Bagaoisan does not teach that blending PEBAX in nylon reduces the modulus of elasticity of the nylon. Bagaoisan plainly teaches that a blend of PEBAX and nylon is a suitable material for the tube portion of the catheter at col. 9, lines 15-16. The objective of decreasing modulus applies only to the tip of the catheter, not to the tube itself.

Bagaoisan does not aim to decrease the modulus of the tube, so Bagaoisan and Beall do not teach away from each other.

4. Applicant's arguments on pages 13-15 of the After Final Amdt. that support Applicant's third point of argument have been fully considered but are not persuasive. Examiner requests evidence that hardness is equivalent to modulus as Applicant indicates in the last sentence of the second full paragraph of page 13 of the After Final Amdt. The effect of blending PEBAX with EVOH on the modulus of EVOH is irrelevant to the instant application. Tse is relied upon only to teach that nylon 12 is a common nylon used as the polyamide component of PEBAX. Applicant's discussion regarding claim 19 on page 14 of the After Final Amdt. is irrelevant because claim 19 was cancelled prior to preparation of the Final Rejection. Examiner requests evidence that lubricity is related to degree of dirt retention as Applicant indicates in the first three lines of page 14 of the After Final Amdt. (see also claim 19). Anti-static properties are not claimed in the instant application.

5. Applicant's arguments on pages 15-18 of the After Final Amdt. that support Applicant's fourth point of argument have been fully considered but are not persuasive. In regard to subpoint A discussed on page 16 of the After Final Amdt., the Final rejection identifies the result effective variable as flexibility; the result effective variable need not be the particular result effective variable/s Applicant had in mind while developing the

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claimed subject matter. In regard to Applicant's claim of unexpected results on pages 15-18 of the After Final Amdt., it is not seen how it would be unexpected that addition of reinforcing filler to a blend without reinforcing filler would increase the modulus.

Regardless, since newly submitted claims 86-108 have not been entered, the rejections of claims 67, 74 and 79 under 35 U.S.C. 112 made of record in paragraph 11 of the Final Rejection stand.

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

08/12/04 WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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8/13/04